

REMARKS/ARGUMENTS

In response to the Office Action mailed July 28, 2004, Applicant amends his application and requests reconsideration in view of the amendments and the following remarks. In this amendment, claims 1 and 8 have been amended, no claims have been cancelled without prejudice and no claims have been added so that claims 1, 2 and 4-8 remain pending.

Claims 1, 2, 4-8 were rejected as being unpatentable over U.S. Patent No. 5,690,644 to Yurek et al. (Yurek) in view of U.S. Patent No. 5,647,858 to Davidson (Davidson). This rejection is respectfully traversed.

The MPEP, in section 706.02(j), sets forth the basic criteria that must be met in order to establish a *prima facie* case of obviousness.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. In re Vaeck, 947 F.2d,488,20 USPQ2d 1438 (Fed.Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.”

Section 2143.03 of the MPEP clarifies certain criteria in section 706.02(j).

“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.

In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1074). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).”

Yurek et al. discloses an apparatus for deploying self-expanding stents. The apparatus comprises an exterior catheter made from a thermoelastic elastomer and an interior catheter. The exterior and interior catheter are designed such that the coefficient of friction of the exterior catheter along its interior surface is less than the coefficient of friction of the interior catheter along its exterior surface such that the stent does not move during deployment.

Davidson discloses metallic catheters coated with a layer of blue to black zirconium oxide or zirconium nitride.

The references, whether taken alone or in combination, fail to disclose or suggest the claimed invention. The references fail to disclose an outer sheath formed from two distinct layers; namely, a polymeric layer and a pyrolytic carbon and/or ceramic layer in combination with an inner shaft.

Assuming for the sake of argument that the references, when combined, do teach all of the claimed elements, there is surely no motivation to combine the references. “When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references.” *In re Rouffet*, 149 F.3d 1350, 1355 (Fed.Cir.1998). “Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability – essence of hindsight.” *In re Demiczak*, 175 F.3d 994, 999 (Fed.Cir.999). “One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Fine*, 837 F.2d 1071, 1075 (Fed.Cir.1988).

Since Yurek utilizes the coefficient of friction to solve the problem, there would be no motivation to one skilled in the art to look to Davidson for the addition of a separate layer. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

A favorable action on the merits is earnestly solicited.

Respectfully submitted,

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